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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,102	08/21/2003	Daniel W. Aberle	SWA 305B	9872
23581	7590	01/12/2006	EXAMINER	
KOLISCH HARTWELL, P.C. 200 PACIFIC BUILDING 520 SW YAMHILL STREET PORTLAND, OR 97204			KIM, YOON YOUNG	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/647,102

Applicant(s)

ABERLE ET AL.

Examiner

Yoon-Young Kim

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>0204</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13, drawn to a filter assembly, classified in class 210, subclass 136.
  - II. Claims 14-22, drawn to a filter assembly for removing pollutants from stormwater, classified in class 210, subclass 459.

2. The inventions are distinct, each from the other because:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as in a filter assembly that does not comprise a filter screen or granular filter medium. See MPEP § 806.05(d).

Restriction for examination purposes is proper because these inventions are distinct for the reasons given above and also because (i) they have acquired a separate status in the art as shown by their different classification, (ii) the search required for the respective groups is not necessarily required by each of the other groups, and (iii) their subject matter is recognized as divergent.

3. During a telephone conversation with Peter Heuser on January 3, 2005 a provisional election was made with traverse to prosecute the invention of the filter assembly for removing pollutants from stormwater, Claims 14-22. Affirmation of this election must be made by

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applicant in replying to this Office action. Claims 1-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 14-22 are rejected under 35 U.S.C. 103(a) as being obvious over Lenhart, Jr. et al., U.S. Patent No. 6,027,639 in view of Dolvet et al., U.S. Patent No. 5,649,639.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter

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disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Regarding Claim 14, Lenhart discloses a filter assembly for removing pollutants from stormwater, comprising: a cylindrical hood (H) having a lower edge, the hood incorporating a horizontally-aligned array of voids (S) near the lower edge; a cylindrical drainage space (#20) disposed concentrically within the hood; a filter (F), disposed in the annular space between the hood and the drainage space, and in fluid communication with the drainage space. However, Lenhart does not disclose a check valve or a check valve cap. Dolvet teaches a container with a check valve (#120) and a check valve cap (#113). It would have been obvious to one of ordinary skill in the art to modify the venting device of Lenhart with the element of Dolvet in order to allow the assembly to breathe without the incursion of contaminants or moisture (Col. 2, Lines 62-64).

Regarding Claim 15, Dolvet discloses that the check valve cap is configured to preserve an air-filled void (#104a).

Regarding Claim 16, Lenhart discloses that the filter comprises a cylindrical screen (#12) that physically filters the stormwater.

Regarding Claims 17-18, Lenhart discloses that the filter further comprises a granular filter medium.

Regarding Claim 19, Dolvet discloses that each void (#115) is vertically elongate with rounded edges.

Regarding Claim 20, Lenhart discloses a drain manifold (#46) disposed within the hood that is in fluid communication with the drainage space; a drain valve (#34) disposed between the drainage space and the drain manifold, the drain valve configured to partially or completely restrict water flow from the drainage space into the drain manifold and thereby moderate the water flow through the filter; and a float assembly comprising a buoyant float (#28) within the drainage space and a linkage (#38) connecting the float to the drain valve, the float assembly configured so that when the drainage space fills with water to a determined depth, the float assembly rises and fully opens the drain valve to permit increased water flow from the drainage space into the drain manifold.

Regarding Claim 21, Lenhart discloses that the increased water flow from the drainage space into the drain manifold establishes a siphon effect that draws additional stormwater through the filter and into the drainage space, the siphon effect continuing until air entering the hood via the array of voids disrupts the siphon effect, lowers the float assembly, and restricts water flow from the drainage space into the drain manifold (Col. 3, Line 49 – Col. 4, Line 14).

Regarding Claim 22, Lenhart discloses that air entering the hood via the array of voids creates turbulence in a region between the hood and the filter, dislodging particulate matter that has accumulated on the filter (Col. 4, Lines 22-35).

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**Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yoon-Young Kim whose telephone number is (571) 272-2240. The examiner can normally be reached on 8:30-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YK  
01/06/2006

  
W. L. WALKER  
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